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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/182,825	10/29/1998	WARNER R.T. TEN KATE	PHN-16.695	2426

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EXAMINER

HONG, STEPHEN S

ART UNIT PAPER NUMBER

2178

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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File 603

**Advisory Action**

Application No.  
**09/182,825**

Applicant(s)  
**Ten Kate**

Examiner  
**Stephen Hong**

Art Unit  
**2178**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Nov 27, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attached sheet
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: \_\_\_\_\_
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

STEPHEN HONG  
PRIMARY EXAMINER  
ART UNIT 2178

### **Continuation of Item 5:**

Applicant argues that the rejection of Claims 28-34 under 35 USC 101 is improper. In supporting the argument, Applicant alleges that the Examiner is citing "old cases about printed matters." Applicant then asserts that "In Re Lowry, 32 USPQ 2d 1031 (Fed. Cir. 1994), ... made clear that data structures of the sort claimed here are patentable subject matter under 35 USC 101." Examiner disagrees. It is unclear to what "the sort claimed" the Applicant is referring. However, what In Re Lowry, did was to allow the "functional" data structures to be patentable subject matter under 35 USC 101. That is, the "sort" that Applicant claimed in claims 28-34 are not functional data structure, and thus, are not patentable subject matter under 35 USC 101 even though the data structures may be embodied on a computer readable medium.

To help Applicant better understand, an example of a non-functional data structure may be, for example, a text file (e.g., ASCII) of a book report embodied on a computer readable medium. The text file is a form of data structure, and is embodied on a computer readable medium. However, the text file itself is simply a descriptive material without any "functions." Therefore, just because it resides on a computer readable medium, that does not automatically make it statutory under 35 USC 101. Now, looking at the Applicant's Claim 28, for example, the claim recites a "presentation element with a play-out specification." This, too, is simply a descriptive material. The claim does not have any functional step, that for example, would read the play-out specification and perform the play out of the media. In other words, it is similar to having a musical notes stored on a computer medium, without the functional steps of reading the notes and outputting the sound, for example.

Secondly, Applicant alleges on page 2 of the remarks that :

*A presentation element is defined at page 6, lines 8-9 of the specification, "A presentation element is part of the presentation, like a still image of piece of text, which at any given moment is presented in the presentation." In other words, the actual content, i.e., the presentation element, is included in the segment.*

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the actual content.. is included in the segment") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In other words, as currently claimed, the Claim only requires "a presentation element", which is clearly anticipated by the prior art of Moorby. Applicant simply cannot *choose* to use such broad language in the claim limitation and then alleges that the "limitations from the specification are not read into the claims."